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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,330	04/28/2004	Mark Ruttenberg	46514-57639	3329

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THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS, MO 63101

EXAMINER

LE, KHANH H

ART UNIT	PAPER NUMBER
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3688

NOTIFICATION DATE	DELIVERY MODE
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10/02/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/709,330	Applicant(s) RUTTENBERG, MARK	
	Examiner KHANH H. LE	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>07/19/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This Office Action is responsive to the original application. Claims 1-20 are pending. Claims 1, 17 and 20 are independent.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3, 11, 12-16, 19-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3: wherein the leasing should be wherein the leasing agreement.

Claim 12: “purchased by the outlet” is not clear. Should be “ purchased at the outlet” since specification at [0056], in discussing ad effectiveness, implies purchased by the consumers at the outlet. (Interpreted as such for prior art application)

Claims 13-16, dependents of claim 12, are rejected based on their dependency.

Claim 14: “and provided” is not clear. Is it the read information that is provided?

Claims 11, 19: “can” is indefinite. Is the step actually performed?

Claim 20: “altering” is not clear; ...”the altering at least one electronic advertisement .. is selected from the group consisting of a type of the advertisement...timing of the advertisement...” is not clear . It is not clear how an alteration can be selected. What really

is claimed is changing the ad or substituting another ad by changing factors that determine the ads.

Appropriate corrections are required.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-11, and 17-19 are rejected under 35 U.S.C. 101 because the claimed inventions are directed to non-statutory subject matter.

Claims 1 and 17:

The claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claim fails to meet the above requirements because the steps are neither tied to another statutory class of invention (such as a particular apparatus) nor physically transform underlying subject matter (such as an article or materials) to a different state or thing.

Here, the methods are not tied to another statutory category except for the nominal use of an electronic display. However nominal use of the electronic display does not pass muster under present understanding of 35 U.S.C. 101. See the analysis of *Ex Parte Langemyr*, USPTO Board

of Appeals and Interferences, Appeals 2008-1495 (Informative Opinion)

<http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf>, (rationale at page 20).

In *Langemyr*, the BPAI reasoned “ *Nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. See Benson, 409 U.S. at 71-72. As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter."* Comiskey, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). *Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process.*

In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law. Cf. Flook, 437 U.S. at 593 (rejecting the respondent's assumption that "if a process application implements a principle in some specific fashion, it automatically falls within the patentable subject matter of 5 101," because allowing such a result "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature.").

In this case, we decline to allow clever claim drafting to circumvent the principles underlying the Supreme Court's interpretation for "process." The only recitation of structure is in the nominal recitation in the preamble citing a "method executed in a computer apparatus." This recitation is so generic as to encompass any computing system, such that anyone who performed this method in practice would fall within the scope of these claims. Thus, the recitation of a computer apparatus in the preamble is not, in fact, a limitation at all to the scope of the claim, and the claim is directed, in essence, to the method performed by any means.

As such, we fail to find that this recitation alone requires the claimed method to include a particular machine such that the method qualifies as a "process" under Section 101. We will

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not allow such a nominal recitation in the preamble to convert an otherwise ineligible claim into an eligible one."

Here the invention focus appears to be on the parties and the contractual obligations. The electronic display is merely the subject of the leasing step i.e. the leasing step is not really " tied " to it as required by the above cited case law. The obtaining revenue step does not involve another statutory class. The advertisements providing step involves the electronic display but what really is involved are just transmitting and storing of data (advertisements) to be displayed.

Thus the electronic display is but the mere use of a nominal structure to transmit and store data necessary for application of the mental process of leasing and collecting revenue thus "may not make the claim patentable subject matter." It is only an incidental physical limitation for data transfer and storage and thus is not enough to convert an abstract idea into a statutory process. As a nominal or token recitation of structure in a method claim, it does not convert an otherwise ineligible claim into an eligible one. As reasoned by the BPAI above, to permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law.

Claims 2-11, and 18-19 suffer from the same defects.

Claims 12-16 and 20 are considered statutory because the altering an electronic advertisement steps seem to be more than insignificant post-solution activities and to require a tie to the electronic display.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1-4, 5-7, 8-9, 11 and 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camporeale US 20040073484 A1 in view of “Daktronics Equipment Leasing”, downloaded on 7/23/2008 from http://web.archive.org/web/20021023091415/http://www.daktronics.com/dak_service.cfm?page=lease, herein “Daktronics”.**

Claims 1-4:

Camporeale discloses electronic display advertising method and apparatus . Camporeale is about selling ad spaces to advertisers and paying the venue owner. Venue owners can buy or rent the displays.

Relevant excerpts of Camporeale are as follows (bold emphasis added):

ABSTRACT:

*A system for electronic display advertising is provided in which advertisers are presented with advertising venues for automated display of selected advertisements. Advertisements are inspected for content acceptability. The advertisements are established as web page static or active displays that are stored in and transmitted from a server. **The advertiser selects venues and times for advertising display. Proceeds from advertisers are divided between the system operator and the display venue-providing entity.***

[0025] Referring now to FIG. 2, the process by which an advertising venue is brought into the system is described. An advertising venue provider is evaluated and approved for

*inclusion in the network. Once approved, **the advertising venue provider signs an agreement, 2-01, and gives the system operator** a range of information that is pertinent to the effective implementation of the system, for example, entity identification, type of venue (drugstore, supermarket etc.), type and size of display area where the display units will be used, etc. The venue provision agreement is customized to take into account the current status of the advertising venue with respect to computer and display equipment and network access availability. A determination is made in step 2-03 whether an acceptable level of network connection, i.e. speed and bandwidth, presently exists in the venue. If yes, step 2-04 is passed over. If no, the venue providing entity obtains an acceptable level of network connectivity in step 2-04 or may be provided one by the system operator. **Thereafter, the venue owner rents or purchases computer reception and display equipment at step 2-05, or the system operator may elect to provide the equipment, installation and servicing of same at its cost.***

CAMPOREALE discloses retailers renting but does not specifically disclose leases, as claimed. However, Daktronics teaches suppliers of electronic displays offering customized leases to businesses of all kinds and sizes (p. 1).

Thus it would have been obvious to a person having ordinary skill in the art at the time the invention was made (herein a “PHOSITA”) to substitute to Camporeale’s rents D. 's leases as these agreements are substantial financial substitutes of each other. Since the result would just be that the retailer has to perform under the lease contract rather than under the rental one, the result would have been predictable to a PHOSITA thus the substitution would have been obvious.

Thus Camporeale in view of Daktronics as discussed above, disclose **claims 1-4, i.e. :**

A method for providing electronic advertising within a retail outlet comprising: leasing at least one electronic display to at least one retail outlet; providing a plurality of electronic advertisements to at least one processor via a network for display on the at least one electronic display; and obtaining revenue from at least one advertiser sponsoring at least one electronic advertisement of the plurality of electronic advertisements (Camporeale, abstract) .

wherein the leasing of the at least one electronic display is selected from the group consisting of a leasing agreement ; and

wherein the providing of a plurality of electronic advertisements to at least one processor (e.g., server 1-01 of Figure 1) via a network for display on the at least one electronic display (see Fig 1) is through a **supplier** (e.g. one of Camporeale's advertisers or the system operator, see abstract; [0024])).

Thus Camporeale in view of Daktronics as discussed above, also disclose:

Independent claim 17 and claim 2, dependent of claim 1:

A method for providing electronic advertising within a retail outlet comprising: leasing at least one electronic display to at least one retail outlet **with a third party leasing company that owns the at least one electronic display (the Camporeale's "system operator who can provide the display, or Daktronics's read on such third party)**; providing a plurality of electronic advertisements to at least one processor via a network for display on the at least one electronic display from a supplier; and obtaining revenue from at least one advertiser sponsoring the plurality of electronic advertisements (Camporeale, abstract).

Camporeale in view of Daktronics as discussed above, also disclose:

Independent claim 18 and claims 6-7, dependent of claim 4:

Camporeale in view of Daktronics as discussed above, disclose claims 17 or 4 and further discloses: wherein the supplier selected from the group consisting of a distributor, a broker, an advertising organization (e.g. Camporeale's system operator can be considered a distributor, a broker, or an advertising organization while Camporeale's advertisers can be considered advertising organizations since none of these terms are specifically defined as explained further

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in the Note on interpretation of claim terms below), a manufacturer, and a vendor (e.g. one of Camporeale's advertisers can be a manufacturer, and a vendor).

(Note on interpretation of claim terms: Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so with reasonable clarity, deliberateness, and precision" (MPEP 2111.01 IV). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ... ". See also MPEP 2173.05(a).

Here no specific definition was found as to the above-discussed claim terms.)

Claim 5:

CAMPOREALE and DAKTRONICS discloses the method of claim 4, and but does not disclose the leasing of the at least one electronic display is provided by the supplier (interpreted as the Camporeale's system operator) . However since CAMPOREALE discloses that the system operator may provide the equipment *installation and servicing of the electronic displays [0025]*, *thus it would have been obvious to a PHOSITA that the* CAMPOREALE system operator could provide its electronic displays, under a lease agreement as taught by Daktronics, in appropriate economic circumstances, if desired, e.g. to increase its revenues.

Claim 8:

The combination of Camporeale and Daktronics discloses the method of claim 7 and CAMPOREALE further discloses the advertising organization (e.g. the advertisers) provides advertising content production.

Claims 9 and 19:

The combination of Camporeale and Daktronics discloses the methods of claims 7 or 17, and CAMPOREALE further discloses the advertising organization the advertising organization provides advertising administration (e.g. Camporeale's system operator provides coordination of ads for the advertisers thus "provides advertising administration") and logistics in advertising sales (Camporeale's system operator provides coordination of ads avails for the retailers/ venue owners thus "provides logistics in advertising sales").

Claim 11:

The combination of Camporeale and Daktronics discloses the method of claim 7 and CAMPOREALE further discloses the supplier can exercise a right to run advertisements on the at least one electronic display and compensate the at least one retail outlet accordingly (abstract).

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Camporeale in view of "Daktronics" as applied to claim 7 and further in view of Official Notice.

Claim 10:

The combination of Camporeale and Daktronics discloses the method of claim 7 but does not explicitly disclose the advertising organization (e.g. the advertisers) provides telemarketing support. However Official Notice is taken that it is old and well-known at the time of the invention that merchants do provide telemarketing support for their customers. Thus it would have been obvious to a PHOSITA that the advertisers (i.e. the merchants) of Camporeale would provide such services when the customers reach them after being exposed to the ads.

9. **Claims 12, 15-16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camporeale in view of “Daktronics” as applied to claim 1 above, and further in view of Myr US 20030220830 A1.**

Claim 12:

The combination of Camporeale and Daktronics discloses the method of claim 1, and but does not disclose determining at least one product that is purchased by the at least one retail outlet; and altering at least one electronic advertisement (of the plurality of electronic advertisements to increase effectiveness of the plurality of displayed electronic advertisements).

However Myr discloses maximizing sales profits by automatic modification of the ads displayed by optimization based on POS data. The optimization is based on many parameters, such as time, store location, *specific display location*, *point of sale (POS)* sales data. Specific store offers can thus be displayed.

See e.g. the following excerpts:

[0030] The OptiRetailChain system also generates special dynamic promotion package offers initiated by the chain operator for any specific store location and creates instant promotion package displays automatically based on individual package pricing and validity rules.

other relevant excerpts:

Abstract: *The present invention is remotely controlled automatic optimization system for maximizing in-store net profits by customized script-generated clip promotions to thousands of individually networked retail display-nodes from central server*

*(OptiRetailChain). The computer-based and machine-learning display system includes: **an advertising optimization function for display nodes, point of sale (POS) data input**, retail database mining engine (RDME), client access and management control module, and in-store networked electronic clip display apparatus. The optimization function obtains data from chain-store database, combines product bundling data, which describe the associative relationships of various product sales in stores with recorded times of sale, inventory costs, margin profits etc. **Physical location of purchased products on the store floor-areas are correlated with relevant display-nodes to create optimal clip display program (playlist) configurations for that specific display location and time.** Most preferred product advertising combinations will be displayed in the **best time slots** for each node automatically. OptiRetailChain uses two methods of promotion optimization: real time scheduling and longer-term statistical optimization. **Utilizing the machine learning capabilities, actual video-clip playlists will be dynamically updated for every display-node and respond to daily sales fluctuations for that store display location. This enables the optimization system to effectively control and automatically feature target advertising to large number of display-nodes in supermarket chain networks optimizing advertising capital without necessitating outside intervention.***

Thus it would have been obvious to a PHOSITA to combine the above features of Myr with Camporeale and Daktronics to allow optimization of advertising as taught by Myr.

Claim 15 :

The combination of Camporeale and Daktronics and Myr discloses the method of claim 12 and CAMPOREALE does not but Myr does disclose altering at least one electronic advertisement based on factors selected from the group consisting of timing of the e-

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advertisement, and a location of the electronic advertisement within the at least one retail outlet (see excerpt above: Myr teaches the optimization is based on many parameters, such as time, store location, *specific display location*, sales data (see e.g. abstract).

Thus it would have been obvious to a PHOSITA to combine the above features of Myr with Camporeale and Daktronics to allow optimization of advertising as taught by Myr.

Claim 20: substantially parallels claim 15 and thus is rejected on the same basis.

Claim 16:

The combination of Camporeale and Daktronics and Myr discloses the method of claim 12, and Camporeale discloses locating the electronic display at a point of sale location for the at least one product within the at least one retail outlet(see e.g. [0003]). (note: Myr also discloses same (abstract))

10. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camporeale in view of “Daktronics” and Myr as applied to claim 12 above, and further in view of admitted art.

Claims 13-14:

The combination of Camporeale and Daktronics and Myr discloses the method of claim 12 and Myr discloses providing sales data to an inventory server that includes an associated database (Fig 1 item 3 and associated text).

However determining the product purchases by reading universal product codes (UPC's) using an electronic identification mechanism is not specifically disclosed.

However reading universal product codes (UPC's) with a UPC reader is admitted as readily available at retail outlets(specification, [0054]).

Because Myr (in the Camporeale, Daktronics and Myr system) teaches providing POS sales data to an (inventory) server that includes an associated database for optimization, it would have been obvious to a PHOSITA to use ,in the Camporeale, Daktronics and Myr system, the admittedly known product UPC's to monitor sales as taught by Myr and to effect the ad changing and optimization method taught by Myr.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bermel US 6674357 B1 discloses advertisers buying ad slots on for mass transit systems.

****Mowry US 20010032131 A1 discloses electronic, public addressing visual display network, multiple screens, ad selection, scheduling, time, duration**

****Nestel US 20030046162 A1 discloses advertising, entertainment and informational digital networks for out-of-home and outdoor venues**

OBN is a new mass communication medium that enables simultaneous distribution and updates of multi-lingual, short form content (advertisements, news, PSAs, etc,) based upon geographic, ethnic or demographic factors, such as venue, event, time of the day. OBN extends to all outdoor venues regardless of venue ownership. Property owners become network affiliates, converting the current "space rental"

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paradigm of outdoor advertising to a "time purchase" media buy model employed in the television and radio industries.

*Peters, US 20030195800 A1 discloses System and method for smart UPC tag based advertising.

Colas US 20030046152 A1 discloses cooperative creation of electronic ads.

Maggio US 20060282319 A1 discloses method and system for substituting media content.

* degrees of relevance.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh H. Le whose telephone number is 571-272-6721. The Examiner works a part-time schedule and can normally be reached on Tuesday, Wednesday, and Friday 9:00-6:00.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, James W. Myhre can be reached on 571-272-6722. The fax phone numbers for the organization where this application or proceeding is assigned are **571-273-8300** for regular communications and for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-3600. For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314)..

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

September 28, 2008

/Khanh H. Le/

Examiner, Art Unit 3688